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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/892,527
Filing Date: June 28, 2001
Appellant(s): GRASSO, STEPHANIE

Fred Grasso
For Appellant

EXAMINER'S ANSWER

MAILED
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GROUP 3700

This is in response to the appeal brief filed 1/27/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

The appellant's statement of the issues in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-11 and 13-19 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appeal d

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5600902	YAVITZ	2-1997
6032386	EVANS	3-2000
5836090	SMITH	11-1998
3643352	ADAIR	2-1972
4525939	MCNEIL ET AL	7-1985
4299037	CAREY	11-1981
4377042	BAUER	3-1983
3009269	FOLK	11-1961
5615495	MASTROCOLA	4-1997
4327503	JOHNSON	5-1982
Des 105159	WILCOX	6-1937

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yavitz (5600902) in view of Evans (6032386).

Yavitz shows a footwear system comprising an athletic foot covering/sneaker (12) and a planar removable outsole (52, figures 8 and 9) with a rigid plate (62) and a single continuous elastic band (60) for attaching the removable outsole to the sneaker and the outsole having traction means (note column 4 lines 9-11) substantially as claimed

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except for the sole of the sneaker being planar and the exact traction means on the removable outsole. Evans teaches a well known alternative type of sneaker which has a substantially planar sole (24 or 152) and a removable outsole (28 or 160) which has traction means comprising a plurality of cleats (30 or 204). It would have been obvious to use a sneaker with a planar sole as is well known and taught by Evans and to provide a plurality of cleats as the traction means on the removable outsole as taught by Evans in the footwear system of Yavitz to provide a different known style of sneaker and to provide increased traction, different levels of traction, or different types of traction.

Evans clearly teaches many different variations in types of traction means located on the foot covering/sneaker and the removable outsole (column 7 lines 26-32). Evans also teaches the use of additional means for attaching removable outsoles to the sole of a sneaker (see column 6 line 66- column 7 line 15). Evans also suggests the use of different spike designs (see column 7 lines 21-26).

2. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, and 8 above, and further in view of Adair (3643352) and Smith (5836090).

Yavitz as modified above shows a system substantially as claimed except for a toe cap and an anchor strap/support band. Smith '090 teaches providing an anchor strap/support band (16 and 16') on a removable outsole. Adair teaches providing a toe cap (shown at 12 in figure 1) in a spiked removable outsole. It would have been obvious to provide a toe cap as taught by Adair and to provide an anchor strap/support

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band as taught by Smith '090 in the system of Yavitz modified above to provide a more secure attachment of the outersole to the foot covering/sneaker.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of McNeil (4525939) and/or Carey (4299037).

Yavitz as modified above shows a system substantially as claimed except for forming the cleats as turf knobs which are part of the outersole. McNeil and/or Carey teaches forming cleats as turf knobs which are formed as part of outersoles. It would have been obvious to form the cleats as turf knobs as taught by McNeil and/or Carey in the system of Yavitz as modified above to reduce the cost and weight of the outersole.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Bauer (4377042), Folk (3009269), or Mastrocola (5615495).

Yavitz as modified above shows a system substantially as claimed except for the bands being tapered. Bauer, Folk, or mastrocola teaches forming bands with tapered walls (32, 22, or 38). It would have been obvious to taper the bands as taught by either Bauer, Folk, or Mastrocola in the system of Yavitz to provide a smoother appearance of the connecting area between the foot covering and the removable outersole.

Yavitz as modified above discloses the claimed invention except for the exact material for the band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use spandex rubber for the band, since it has been held to be within the general skill of a worker in the art to select a known material

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on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

5. Claims 7, 10, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 8 above, and further in view of Johnson (4327503).

Yavitz as modified above shows a system and inherent method of using the system substantially as claimed except for the heights of the cleats, i.e. the cleat pattern. Johnson teaches a cleat pattern in which the perimeter cleats (30a-30g) are of greater height than the central cleats (32). It would have been obvious to use a cleat pattern as taught by Johnson in the system and inherent method of using a system of Yavitz as modified above to provide traction means/cleat pattern which is appropriate for both natural surfaces and artificial surfaces.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 8 above, and further in view of Adair (3643352) and either Bauer (4377042), Folk (3009269), or Mastrocola (5615495).

Yavitz as modified above shows a system substantially as claimed except for the bands being tapered. Adair teaches providing a toe cap on a removable outersole. Bauer, Folk, or Mastrocola teaches forming bands with tapered walls (32, 22, or 38). It would have been obvious to provide a toe cap as taught by Adair and to taper the bands as taught by either Bauer, Folk, or Mastrocola in the system of Yavitz to provide a more secure attachment of the outersole, to protect the toe of the footwear and provide

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a smoother appearance of the connecting area between the foot covering and the removable outersole.

7. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 13, 17, and 19 above, and further in view of Smith (5836090).

Yavitz as modified above shows a system and inherent method of use substantially as claimed except for a toe cap and an anchor strap/support band. Smith '090 teaches providing an anchor strap/support band (16 and 16') on a removable outsole. It would have been obvious to provide an anchor strap/support band as taught by Smith '090 in the system of Yavitz modified above to provide a more secure attachment of the outsole to the foot covering/sneaker.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 14 and 15 above, and further in view of Adair (3643352).

Yavitz as modified above shows a system and inherent method of use substantially as claimed except for a toe cap. Adair teaches providing a toe cap (shown at 12 in figure 1) in a spiked removable outsole. It would have been obvious to provide a toe cap as taught by Adair in the system and inherent method of use of Yavitz modified above to provide a more secure attachment of the outsole to the foot covering/sneaker.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 13 above, and further in view of Wilcox (Des 105159).

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Yavitz as modified above shows a system and inherent method of use substantially as claimed except for the exact shape of the cleats. Wilcox teaches forming cleats in the shape of a truncated cone having inwardly bowed sidewalls (see figure 1). It would have been obvious to shape the cleats as taught by Wilcox in the system and inherent method of use of Yavitz to provide a different design, to reduce the weight of the shoe, etc..

(11) Response to Argument

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicants' arguments directed towards the combination of Yavitz and Evans, the mere reversal of the elements, i.e. the spikes and treaded surface would not defeat the purpose of the system of Yavitz. The system of Yavitz would still function to allow a user to have a spiked footwear when needed and a spikeless footwear for putting and the use of the system would still protect greens as desired and intended by Yavitz. The user would simply put the removable sole on for providing a spiked sole and remove the removable sole when putting or on floor/hard surfaces and needing a spikeless sole. Evans clearly and explicitly provide the motivation for providing a spikeless permanent sole with spiked removable sole as an alternative to a spikeless removable sole and spiked permanent sole. Also, it is noted that it has been held that a

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mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

In response to applicants' arguments directed towards the rejection of claim 8, Evans clearly states "it is expressly contemplated that the base section can be spikeless and that various overlying soles can include spikes" in column 7 lines 25-30.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, Evans clearly and explicitly provides the motivation for combining as pointed out above in the rejections and as clearly shown in the different embodiments of Evans as obvious alternative arrangements of the traction providing elements.

In response to applicants' argument that Yavitz teaches away from the suggested combination, Yavitz clearly teaches a system to modify/alter/provide a different traction means to the bottom sole of a shoe. The resultant combination would still provide such. It is also noted that Yavitz clearly states that "other modifications may be made in the

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design and arrangement of the elements without departing from the scope of the invention" (see column 4 lines 25-28).

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

In response to applicants' arguments/disagreement directed towards the motivation of reduction of weight and cost, such motivations are well known and conventional in the art of footwear. Many manufacturers in today's footwear market are concerned with the weight of the shoe for improved athletic performance, reduction in shipping costs, etc..

In response to applicants' arguments directed towards the rejection of claim 4, Yavitz clearly shows a planar removable outsole shaped as claimed in figures 8 and 9.

In response to applicants' arguments directed towards the rejection of claims 7, the smaller cleats are truncated, i.e. there is no pointed end. The fact that the end is rounded reinforces the fact that the cone is truncated.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



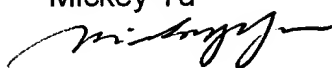
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February 19, 2004

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